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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,701	10/15/2004	Teruhiko Suzuki	260020US6PCT	9481

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EXAMINER	
PE, GEEPY	

ART UNIT	PAPER NUMBER
2621	

NOTIFICATION DATE	DELIVERY MODE
12/12/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/510,701	SUZUKI, TERUHIKO	
	Examiner	Art Unit	
	Geepy Pe	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *18 and 19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 October 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/15/2004, 2/29/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of **Group I** (claims 1-17) in the reply filed on 9/22/08 is acknowledged.

2. Claims **18-19** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/22/08.

Drawings

3. Figures **1 and 2** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **7**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is

being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **217, 214**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: Pg. 21, line 11, applicant should add -- a -- before "graph".

Appropriate correction is required.

.Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims **7, 8, 16, and 17** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A) The Examiner notes that "...computer-readable program..." or "...program..." does not specify how the instructions are (a) associated with the medium, or (b) the nature of instructions. Data structures not claimed as embodied (or encoded with or embedded with) in a computer readable medium are descriptive material per se, and are not statutory, *Warmerdam, 33 F.3d at 1361, 31, USPQ2d at 1760).* Similarly, computer programs claimed as computer listings, instructions, or codes are just the descriptions, expressions, of the program are not "physical things". They have neither computer components nor statutory processes, as they are not "acts" being performed. In contrast, a claimed "... computer readable medium encoded with a computer program..." is a computer element which defines structural and function interrelationships between the computer program and the rest of the computer, and is statutory, *Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035, Interim Guidelines, Annex IV (Section a).*

B) The computer program as claimed is not properly associated with the operation. It is quite possible that the computer program may be an unrelated sub-routine or a simple commence instruction which then causes the computer to execute the operation that could be self-resident, and not encoded on the medium, *Interim Guidelines, Annex IV (Section b).*

Applicant should amend the claim(s) and the specification, as needed, to comply with the requirement of MPEP 2106.01.I.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims **1-13 and 15-17** rejected under 35 U.S.C. 102(e) as being anticipated by Tahara et al. (U.S. Pat. 6,671,323; hereinafter Tahara)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Re. **claim 1**, Tahara teaches an encoding device (col. 1, lines 7-8) including: generating means for generating a header to which reference is made as needed during decoding (col. 8, line 12; Figs. 11, 22, 23, 26, 28C & 29: i.e., headers are generated for use in the MPEG stream); encoding means for encoding the header generated by the generating means and an input image signal, respectively (col. 1, lines 7-8; Figs. 1 & 2, element 2; Fig. 4; Fig. 28C); and outputting means for multiplexing the header and the image signal encoded by the encoding means and outputting a bitstream (Fig. 4; col. 6, lines 28-43); the encoding device being characterized in that the generating means generates the header containing buffer characteristic information about buffering during decoding of the bitstream (Fig. 11; col. 14, lines 5-8).

Re. **claim 2**, Tahara teaches that the generating means generates the header containing the buffer characteristic information for each predetermined section randomly accessible in the bitstream (col. 1, lines 18-20: i.e., the since the video data is randomly accessible, the header, in turn, is as well).

Re. **claim 3**, Tahara teaches that the generating means generates the header containing the buffer characteristic information for an entire sequence of the bitstream (Fig. 11: i.e., the header contains buffer information for the whole sequence).

Re. **claim 4**, Tahara teaches that the buffer characteristic information contains all of a minimum bit rate R_{min}, a minimum buffer size B_{min}, and a minimum delay amount F_{min} which are decodable during decoding of the bitstream (Figs. 11 & 23).

Re. **claim 5**, Tahara teaches that the buffer characteristic information contains at least one of a minimum bit rate R_{min}, a minimum buffer size B_{min}, and a minimum delay amount F_{min} which are decodable during decoding of the bitstream (Figs. 11 & 23).

Re. **claims 6-8**, the claim(s) recites analogous limitations to claim(s) 1 above, and is/are therefore rejected on the same premise.

Re. **claim 9**, Tahara teaches a decoding device (Figs. 1 & 2, element 3; col. 1, lines 8-9) characterized by including: searching means for searching for a header in an input bitstream (Fig. 4; col. 6, lines 11-14: i.e., the header is searched within the stream to being the decoding process); and decoding means for reading buffer characteristic information about buffering, which information contained in the header found by the searching means, and for decoding the bitstream in accordance with the read buffer characteristic information (Figs. 1 & 2, element 3; Fig. 4; col. 11, lines 64-66; Fig. 10: i.e., the syntax is also used within the decoding process).

Re. **claim 10**, the claim(s) recites analogous limitations to claim(s) 2 above, and is/are therefore rejected on the same premise.

Re. **claim 11**, the claim(s) recites analogous limitations to claim(s) 3 above, and is/are therefore rejected on the same premise.

Re. **claim 12**, the claim(s) recites analogous limitations to claim(s) 4 above, and is/are therefore rejected on the same premise.

Re. **claim 13**, the claim(s) recites analogous limitations to claim(s) 5 above, and is/are therefore rejected on the same premise.

Re. **claims 15-17**, the claim(s) recites analogous limitations to claim(s) 9 above, and is/are therefore rejected on the same premise.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tahara as applied to claims **1-13 and 15-17** above, in view of Krause et al. (U.S. Pat. 5,877,812; hereinafter Krause).

Re. **claim 14**, Tahara does not teach that the decoding means creates a buffer characteristic curve from the information read from the bitstream, and the decoding device further includes determining means for determining that the input bitstream is decodable when a characteristic curve of the decoding device is located above the characteristic curve of the bitstream. However, in the same field of endeavor, Krause teaches keeping the buffer fullness over a certain minimum, which in this case would be the curve of the bitstream, in order for a successful decoding, or utilization of a video transmission (Fig. 8) for the benefit of prevent overflow or underflow of the buffer. Therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made that the decoding means creates a buffer characteristic curve from the information read from the bitstream, and the decoding device further includes determining means for determining that the input bitstream is decodable when a characteristic curve of the decoding device is located above the characteristic curve of the bitstream in the Tahara invention, as shown in Krause, for the benefit of preventing overflow or underflow of the buffer. The Tahara invention, now incorporating the Krause invention, has all the limitations of claim 14.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. 6,754,276.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geepy Pe whose telephone number is (571)-270-3703. The examiner can normally be reached on Monday - Friday, 7:00AM - 3:30PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. P./
/Geepy Pe/
Examiner, Art Unit 2621

/Andy S. Rao/
Primary Examiner, Art Unit 2621
December 7, 2008